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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/700,822  | 11/04/2003  | Elmer Algin Rose     | 88030096            | 6250             |
| 34637   | 7590        | 12/06/2004           |                     | EXAMINER         |
| BIDDLE & ASSOCIATES<br>6300 POWERS FERRY ROAD<br>SUITE 600-183<br>ATLANTA, GA 30339 |             |                      | GUSHI, ROSS N       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2833                |                  |

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/700,822             | ROSE, ELMER ALGIN   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Ross N. Gushi          | 2833                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11/15/04
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11/15/04 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The device as claimed being an audio control device or video control device, was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant merely states that the device may be an audio control device or video control device, but no disclosure is made as to how these devices would actually be configured so as to be usable with the yoke as disclosed. The limitations are given little weight.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in —

Art Unit: 2833

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a);

Claims 2, 3, 6, 9, 11, 15, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Glader.

Per claim 2, Glader discloses an electrical device comprising a mounting yoke 13a for mounting said electrical device into an outlet box, where the yoke comprises a slotted mounting hole (that portion of the slot where the bolt B is located) for receiving a mounting screw B, and a channel leading into said slotted mounting hole (see figure 1, the portion of the hole visible on both sides of bolt B).

Per claim 3, mounting screw comprises an elongated post, a head 20 positioned at one end of the elongated post and a support rim 24 positioned along the elongated post at a predetermined distance from said head and in a plane that is substantially parallel to the plane in which said head lies.

Per claim 6, said channel comprises a substantially enclosed opening.

Per claim 9, said channel is generally circular in shape (see figure 1, in particular at least the ends of the channels are circular).

Per claim 11, the electrical device comprises a receptacle.

Claims 15, 16, and 19, are rejected for the reasons pertaining to claims 2, 3, 6, 9,

Claims 2, 3, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Slater et al. ("Slater"). Regarding claims 1, 2, 3, Slater discloses the device as claimed (see figures 1-4). Per claim 12, the device is a switch.

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Eder. Per claim 17, Eder discloses an electrical device comprising a mounting yoke for mounting said electrical device into an outlet box; said mounting yoke comprises: slotted mounting hole 21 (see figure 2) for (i.e. capable of receiving) receiving a mounting screw; and score line 22 delineating a portion of the yoke that can be removed to form a channel that opens into said slotted mounting hole (where the portion of the slot remaining on the extension 16, 18, is capable of being used as the mounting hole).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glader. Regarding claim 10, said Glader channel is configured so as to be large enough to accommodate the head of some mounting screw. At the time of the invention, it would have been obvious to use mounting screws of various sizes, including one where the head could be accommodated in the channel. The choice of which size mounting screw would have been a matter of engineering choice, motivated by well known

considerations such as availability of parts (i.e. it would have been obvious to substitute or use available bolts, including bolts having heads which could be accommodated in the channel.

Claims 4, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glader in view Hubbell et al. ("Hubbell").

Regarding claims 4, 5, the Glader slot does not extend from the outer edge. Hubbell discloses a yoke where the slot 43 extends from an outer edge to the mounting hole (where the mounting hole is the portion of the slot occupied by the screw 3 when the yoke is attached to the box 2). At the time of the invention, it would have been obvious to configure the Glade slot as a slot opened to the outer edge of the yoke as taught in Hubbell. The suggestion or motivation for doing so would have been to simplify attachment of the yoke to the box as taught in Hubbell (col. 1, par. 2).

Per claim 7, said channel comprises two walls that are substantially parallel to each other.

Per claim 8, said channel comprises two walls that converge inward from an outer edge of said mounting yoke into said slotted mounting hole (see Hubbell figure 6, in particular note that inner portion 44 transitions to end portion 38 in a gradual and rounded manner, such that the bent transition portion joining portion 44 to end portion 38 forms a converging inner edge).

Claims 13-14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glader as in claims 2, 3, 6, 9, 10, 11, 15, 16, and 19 in view of Slater. Slater and Glader show a receptacle and a switch, but not other devices such as audio or video

controls. At the time of the invention, it would have been obvious to substitute various devices for the receptacle or switch. The suggestion or motivation for doing so would have been to facilitate mounting of these devices, such motivation being well known in the art.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eder as in claims 17 in view of Slater. Eder discloses a receptacle. Slater shows a switch. At the time of the invention, it would have been obvious to substitute various devices for the receptacle, such as a switch as taught in Slater. The suggestion or motivation for doing so would have been to facilitate mounting of various devices, such motivation being well known in the art.

#### ***Response to Arguments***

Applicant's arguments have been considered. Regarding the 35 USC 112 rejections, applicant argues that the claimed devices are in fact very well known and one skilled would recognize that such devices may be configured to include a yoke such as described. Is it therefore also applicant's position that one skilled in the art would have found it obvious to configure such well known devices with the yokes of the prior art of reference? If applicant is admitting that it would have been obvious to use such devices with well known prior art yokes, applicant should make this clear on the record. Otherwise, if it would not have been obvious (as applicant also argues with respect to the rejection over the prior art), then the examiner is not persuaded that it one skilled in the art would recognize that applicant's yoke could be configured with such devices. How can applicant argue on the one hand that as far as applicant's disclosure is

concerned for 35 USC 112 purposes, the claimed devices are “in fact very well known” while at the same time argue that as far as the using such devices with the yokes of the prior art, such use would not have been obvious? (remarks page 14). Applicant argues that the examiner is using applicant’s disclosure as a “guide through the maze of prior art” (remarks page 14) while at the same time arguing for purposes of 35 USC 112, the undisclosed portions are “in fact very well known” (remarks page 6). The examiner is not persuaded by applicant’s incongruous arguments.

Regarding claims 2, 3, 6, etc., applicant argues that Glader shows merely the portion of the hole on the sides of the bolt. This is no different from applicant’s invention. See for example applicant’s figures 4C, 4D. As disclosed by applicant, the only difference between the “hole” and the “slot” is that the “hole” is that portion of the slot which is occupied by the bold. How can applicant argue that the Glader only shows a elongated hole whereas the same structure in applicant’s invention is a hole and a slot? The same applies to applicant’s arguments regarding Slater. As understood by the examiner, Applicant seems to be attempting to make some kind of distinction between a hole, slot, and a channel, and consequently argue that the prior art does not show one of these features whereas applicant’s invention does. Again, as disclosed in applicant’s invention, see for example applicant’s figures 4C and 4D, applicant’s distinctions between what portion is the hole, the slot, or the channel seems completely vague, ambiguous, and arbitrary.

Applicant seems to be arguing that somehow the Glader device doesn’t work whereas applicant’s invention does because the Glader slot somehow is not big enough

for the screw head. The examiner maintains that one with skill in the art would have recognized that the Glader device could be assembled and used as shown by Glader, for example by angling the bolt head into the slot and popping the bolt head through the slot, recognizing that the sheet metal yoke has natural flexibility and resiliency allowing the slot to be deformed enough to allow the bolt head to be inserted.

Similarly, regarding claim 6, 9, 10, etc., applicant argues that Glader does not disclose the claimed limitations. The examiner maintains that Glader discloses the channel and all the other claimed structures. See e.g. Glader figure 1 which shows the channel on both sides of the bolt.

Regarding Claim 17 and Eder, the examiner has no idea what applicant is arguing and has no comment.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (remarks page 12, 14, etc.), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually (remarks, page 13), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

*Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (571) 272-2005. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at 571-272-2800 extension 33. The phone number for the Group's facsimile is (703) 872-9306.

ROSS GUSHI  
PRIMARY EXAMINER

